

REMARKS

Claims 60-64 and 71-72 are pending. No claims are amended, added or canceled in this Response. Applicants' June 3, 2003 Amendment was considered non-responsive because the remarks did not address the 35 U.S.C. § 112, first paragraph rejection set forth in the December 2, 2002 Office Action. Applicants acknowledge this unintentional oversight and respectfully traverse the rejection as follows.

The Examiner has objected to the phrase "substantially completely biodegradable" as lacking support in the originally filed specification and claims.

Where a term (such as "biodegradable") is not capable of precise mathematical definition, modifiers such as "substantially" are routinely permitted in claim drafting. The Federal Circuit revisited this issue just last month, in the case of Anchor Wall Systems, Inc. v. Rockwood Retaining Walls, Inc., (Federal Circuit, decided August 13, 2003). The court noted that the use of "substantially" is often necessary and acceptable under the law.

[W]e note that words of approximation, such as "generally" and "substantially," are descriptive terms "commonly used in patent claims 'to avoid a strict numerical boundary to the specified parameter.'" Ecolab, Inc. v. Envirochem, Inc., 264 F.3d 1358, 1367 (Fed. Cir. 2001) (quoting Pall Corp. v. Micron Separations, Inc., 66 F.3d 1211, 1217 (Fed. Cir. 1995)); see, e.g., Andrew Corp v. Gabriel Elecs. Inc., 847 F.2d 819, 821-22 (Fed. Cir. 1988) (noting that terms such as "approach each other," "close to," "substantially equal," and "closely approximate" are ubiquitously used in patent claims and that such usages, when serving reasonably to describe the claimed subject matter to those of skill in the field of the invention and to distinguish the claimed subject matter from the prior art, have been accepted in patent examination and upheld by the courts). And, while ideally, all terms in a disputed claim would be definitively bounded and clear, such is rarely the case in the art of claim drafting.

The written description requirement of 35 U.S.C. 112 does not require that the claim language exactly mirror the language in the specification. See M.P.E.P § 2163.02. The test is whether the description allows the ordinary artisan to recognize that the inventor invented what is claimed. Id.

In this case, there is no question that the specification contains support for what is claimed and that the inventor had possession of the invention. At page 3, lines 27-29, reference is made to: "a molded body . . . made from completely decomposable, biodegradable material." The specification at page 1, line 15 provides the basis for using the modifier "substantially," because the specification notes the urgent need for molded containers that are "biodegradable substantially without residue" in the context of a completely biodegradable container. Thus, the specification provides ample support for modifying the phrase "completely biodegradable" with the term "substantially." This is exactly the type of situation where the use of the word "substantially" is appropriate.

Applicants respectfully request that the claims be addressed on the merits. Applicants further submit that the claims are allowable for the reasons set forth in Applicants June 3, 2003 Amendment, which remarks are incorporated by reference herein.

Applicants' undersigned attorney may be reached in our New York office by telephone at (212) 218-2100. All correspondence should be directed to our below listed address.

Respectfully submitted,



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